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REMARKS

Claims 1, 8 and 19 are independent.

Claim 1 stands rejected under 35 U.S.C. § 102 as being anticipated by Coville et al. '956 ("Coville") and Sekiyama et al. '447 ("Sekiyama"), and claims 1, 8 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kikuchi et al. '416 ("Kikuchi") in view of Sekiyama. These rejections are respectfully traversed for the following reasons (it should be noted that the Examiner does not rely on Kikuchi but relies exclusively on Coville and Sekiyama as allegedly disclosing the verifying step of the present invention; indeed, Kikuchi does not obviate the deficiencies of Coville and Sekiyama discussed below).

In order to expedite prosecution, Applicants' representative initiated a telephone interview with Examiner Gordon. Applicants and Applicants' representative would like to thank Examiner Gordon for his courtesy in conducting the interview and for his assistance in resolving issues. During the interview, the Examiner indicated that the feature "wherein step (b) is performed based on a change over time in the output signal" recited in the independent claims could be read broadly as merely requiring verifying an amount of the sample solution held in the cell using any manner such as observing, obtaining, etc., the information by taking the difference in amounts observed/obtained at two discrete times. Accordingly, the Examiner indicated that the discrete measurements in Coville and Sekiyama read on the pending claims.

In order to clarify the distinction between the present invention and cited prior art, the independent claims have been amended to recite "wherein step (b) is performed based on the *rate* at which the output signal changes over time" (emphasis added). Accordingly, it is respectfully submitted that the Examiner's aforementioned interpretation is no longer valid, in that the difference between two discrete measurements of the output signal would NOT suggest that the *rate* at which the difference took place would be a basis for the verification.

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For example, if a first measurement of 10 units is taken at 1pm and a second measurement of 20 units is taken at 2pm, Coville and Sekiyama as interpreted by the Examiner would only base the alleged verification on the fact that there was a difference of 10 units. However, in Coville and Sekiyama, there would be no change in the results of the alleged verification process if the second measurement was taken at 2pm or if taken later, for example, at 5 pm. In contrast, according to one aspect of the present invention, the verification process can take into account whether the second measurement is taken at 2pm or 5pm so that a different result could occur (2pm would represent a higher rate of change than 5pm). In short, Coville and Sekiyama as interpreted by the Examiner would have the same verification for a difference of 10 units regardless of the amount of time between the measurements, whereas the present invention could have a different result for the same difference of 10 units depending on the rate at which the difference took place (*see, e.g., Figure 2 of Applicants' drawings; see also page 18, lines 15 – 23 of Applicants' specification, etc.*).

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in the pending claims because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*,

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819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1, 8 and 19 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.


Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Having fully and completely responded to the Office Action, Applicant submits that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: January 11, 2007